

REMARKS

Claims 1-22 and 27-41 are pending in the application, with claims 27-39 having been withdrawn from consideration, and claims 5, 6, 16, 17, 20 and 21 are canceled herein without prejudice, leaving Claims 1-4, 7-15, 18-20, 40 and 41. The Examiner rejected Claim 41 under 35 U.S.C. §112, first paragraph. The Examiner rejected Claims 2-7 and 9-22 under 35 U.S.C. §112, second paragraph as being indefinite. The Examiner rejected Claims 40 and 41 under 35 U.S.C. §102(a) as being anticipated by Hamalainen et al. (WO 98/36508). The Examiner rejected Claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over Hamalainen et al. in view of Shin-Yokohama (TSG-RAN Working Group 1 meeting #3). The Examiner rejected Claims 40 and 41 under 35 U.S.C. §103(a) as being unpatentable over Kanerva et al. (U.S. Patent 5,793,744).

Regarding the rejection of Claim 41 under §112, first paragraph, Applicants respectfully submit that the rejection is in error regarding the application of *In re Hyatt* (Fed. Cir. 1983). Claim 41 is written to a specific structure (a gating controller) having a specific function (for transmitting data at a forward gating rate different from a reverse gating rate in a gated mode). This is not a “means claim” as considered by *In re Hyatt*, but a specific apparatus claim. M.P.E.P. §2164.08(a) Single Means Claim states that a single means claim is a claim where a means recitation does not appear in combination with another recited element of means. Based on at least M.P.E.P. §2181, withdrawal of the rejection of Claim 41 is respectfully requested.

Regarding the rejection of Claims 2-7 and 9-22 under §112, second paragraph, the Examiner stated that these claims do not particularly point out and distinctly claim the subject matter regarded as the invention. Specifically, Claims 2-7, 9 and 15-18 recite that either the base station or mobile station transmission controller transmits on **both** the uplink and the downlink, which is contradictory. Claims 2, 3, 4, 7, 9, 10, 15 and 18 have been amended to recite either the downlink or the uplink. Based on at least the foregoing amendments,

withdrawal of the rejections of Claims 2-7 and 9-22 is respectfully requested.

Turning now to the rejections of independent Claims 1 and 8 under §103(a), the Examiner states that Hamalainen et al. in view of Shin-Yokohama disclose all of the elements of the claims. Hamalainen et al. discloses a power control method of discontinuous transmission, and Shin-Yokohama discloses a gated transmission of a DPCCH in DCH/DCH control only substates. Claims 1 and 8 have been amended to recite, “the uplink gating rate and the downlink gating rate are compared to set the downlink gating rate different from the uplink gating rate.” As neither Hamalainen et al. nor Shin-Yokohama, nor any combination thereof, teaches or discloses the uplink gating rate and the downlink gating rate are compared to set the downlink gating rate different from the uplink gating rate, withdrawal of the rejections of Claims 1 and 8 is respectfully requested.

Regarding the rejections of independent Claims 40 and 41, the Examiner rejected the claims under §102(a) as being anticipated by Hamalainen et al., and under §103(a) as being unpatentable over Kanerva et al. Hamalainen et al. discloses a power control method of discontinuous transmission, and Kanerva et al. discloses a multichannel high-speed data transfer. To overcome both rejections, the dependent operation of the forward gating rate and the reverse gating rate has been added to teach of these claims, similar to the amendments of Claims 1 and 8. Based on these amendments and arguments similar to those set forth above with respect to Claims 1 and 8, and as Kanerva et al. also does not teach or disclose the uplink gating rate and the downlink gating rate are compared to set the downlink gating rate different from the uplink gating rate, withdrawal of the rejections of Claims 40 and 41 is respectfully requested.

Independent Claims 1, 8, 40 and 41 are believed to be in condition for allowance. Without conceding the patentability per se of dependent Claims 2-4, 7, 9-15 and 18-20 these are likewise believed to be allowable by virtue of their dependence on their respective amended independent claims. Accordingly, reconsideration and withdrawal of the rejections of

dependent Claims 2-4, 7, 9-15, 18-20 is respectfully requested.

Accordingly, all of the remaining claims pending in the Application, namely, Claims 1-4, 7-15, 18-20, 40 and 41, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicants' attorney at the number given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul J. Farrell", is written over the typed name.

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